

II. REMARKS

Applicants gratefully acknowledge that the Examiner has allowed claims 6, 7, 16, 17 and 24-26 (Office Action, dated October 31, 2007, at 3, lines 3-4). Applicants also gratefully acknowledge the Examiner's determination that claims 1-5, 8-15 and 18-23 contain allowable subject matter (Office Action, dated October 31, 2007, at 3, lines 5-10).

Claims 2, 9 and 10 have been cancelled without prejudice. Claims 1, 3, 5, 14, 25 and 26 have been amended. Specifically, independent claim 1 has been amended to include the subject matter of previous claim 2. Therefore, independent claim 1 has the same scope as previous claim 2. Claim 3 has been amended to depend upon claim 1 and to incorporate subject matter from previous claim 9. Claim 5 has been amended to depend on claim 1. Claim 14 has been amended to depend upon claim 12.

The preamble of claims 25 and 26 has been amended to recite "an apparatus for inspecting a target by tera-hertz wave spectroscopic measurement" so as to be in accordance with the preamble of the base claims. Therefore, the present amendment has no further limiting effect on the scope of claims 25 and 26.

The present amendment adds no new matter to the above-captioned application, and raises no new issues.

A. The Rejections

Claims 1-5, 8-15 and 18-23 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Applicants respectfully traverse the Examiner's rejections and request reconsideration of the above-captioned application for the following reasons.

B. Applicants' Arguments

Claims 6, 7, 16, 17 and 24-26 have been allowed. The remaining claims 1-5, 8-15 and 18-23 are in compliance with 35 U.S.C. § 112, second paragraph, for the following reasons, and are likewise in condition for allowance.

The Examiner contends that claims 1-5, 8-15 and 18-23 are indefinite because the term “about” is a term of degree and that the specification does not provide a standard for ascertaining the requisite degree. (Office Action, dated October 31, 2007, at 2, lines 10-15). The Examiner’s contention is flawed because the Federal Circuit has ruled that claims that are not precise may still be definite. Seattle Box Co., Inc. v. Industrial Crafting & Packing, Inc., 221 U.S.P.Q. 568, 573-74 (Fed. Cir. 1984). In fact, the Federal Circuit has held that the term “about,” when used in the claims, is still definite even if some experimentation would be necessary to determine the scope of the claims. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 316 (Fed. Cir. 1983).

In this case, the Examiner contends that the phrase “a plurality of frequencies ranging from about 1 THz to 3 THz” is indefinite because the specification does not provide a standard for ascertaining the requisite degree. The Examiner’s contention is incorrect because Applicants’ specification, at 12, lines 4-8, as originally filed states

“According to the tera-hertz wave generation device 12, operating the switching device 13 (the rotary stage) enables the generation of the tera-hertz waves having different wavelengths in the tera-hertz region of about 1 THz to 3 THz,”

A person of ordinary skill in the art would understand this portion of Applicants’ written disclosure. The claims, however, are interpreted as one of ordinary skill in the art would interpret them in view of Applicants’ written description. Solomon v. Kimberly-Clark Corp., 55 U.S.P.Q.2d 1279, 1282 (Fed. Cir. 2000). Therefore, a person of ordinary skill in the art reading Applicants’ independent claims 1 and 12 would be able to ascertain their scope in

view of Applicants' written description. The Examiner has adduced no facts (e.g., a prior art reference) that would suggest otherwise.

For all of the above reasons, Applicants have established that independent claims 1 and 12 are definite in accordance with the requirements of 35 U.S.C. § 112. Therefore, claims 2-5, 8-11, 13-15 and 18-23, which depend either directly or indirectly upon either claim 1 or claim 12, are definite for the same reasons.

In view of the present amendment, there are no duplicate claims.

III. CONCLUSION

Claims 6, 7, 16, 17 and 24-26 have been allowed. Claims 1-5, 8-15 and 18-23 are in compliance with 35 U.S.C. § 112, second paragraph, for all of the reasons discussed above. Furthermore, the Examiner has admitted that claims 1-5, 8-15 and 18-23 all contain allowable subject matter. Therefore, claims 1-5, 8-15 and 18-23 are in condition for allowance for the reasons of record.

For all of the above reasons, claims 1, 3-8 and 11-26 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below-signed attorney for Applicants.

Respectfully submitted,

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